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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,794	01/06/2000	DAVID S. DIME	018148-00013	4773

7590 12/12/2001

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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 12/12/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/367,794	DIME ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chih-Min Kam	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-66 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicants' amendment of adding new claims 37-59 in Paper No. 5 filed August 28, 2000 is acknowledged. Since the original application has claims 1-43, according to 37 C.F.R. Rule 1.126, the numbering of new claims has been changed to 44-66. Therefore, claims 1-66 are pending.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

1. Group I, claims 1-43, drawn to a compound represented by the formula A-L-D, wherein, A is an anchoring moiety that is specific for first target site on a protein, L is a linking group, and D is a drug that is specific for a second target site on the protein, and a method for the localization of a drug at a preselected target site comprising administering to a host a compound of A-L-D, classified in class 514, subclass 2.

Should Group I be elected, applicant is required to select one anchoring moiety from a sulfhydryl reactive group (claims 3, 4, 33 and 34), an alkylating agent (claims 6 and 35, e.g., diazoketones and  $\alpha$ -halo ketones) or an acylating agent (claims 6 and 35, e.g., pentafluorophenyl esters and 2,4-dinitrophenyl esters). Applicant is also required to select one drug from an antineoplast (claims 21 and 22), a local anesthetic (claims 23-25) or an antihypertensive (claims

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26-29), and select one protein to which the drug binds from  $\beta$ -adrenergic receptor (claims 38 and 41), a calcium channel (claims 39 and 42) or a sodium channel (claims 40 and 43).

2. Group II, claims 44-66, drawn to a method for identifying a drug that binds at a preselected target site on a biological molecule comprising providing the preselected target site having a chemically reactive group, contacting the biological target molecule with a drug having an anchoring moiety specific for the chemically reactive group, and identifying the drug having the anchoring moiety, classified in class 514, subclass 2.

Should Group II be elected, applicant is required to select one drug in claims 46, 53 and 62, one protein to which the drug binds in claims 48, 55 and 64, and one anchoring moiety in claims 49-50, 56-57 and 65-66.

The claims of these groups are directed to different inventions which are not linked to form a single general concept. The claims in the different groups do not have in common the same or corresponding technical features; e.g., the methods of Group I and Group II are alternative processes of using the compound of formula A-L-D. In particular, each group is directed to a distinct method which has different method steps, use different materials and produce different effects. Accordingly, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept and lack of unity is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Joseph Snyder on December 10, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D.  
Patent Examiner

*CMK*

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December 4, 2001

*Christopher S. Low*  
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